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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,801	06/05/2001	Peter Simonelli	231.301	5916

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EXAMINER

YIP, WINNIE S

ART UNIT PAPER NUMBER

3637

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/874,801

### Applicant(s)

SIMONELLI ET AL.

### Examiner

Winnie Yip

### Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 14-18, 24, 26, 28, 29, 31-33, 37-39 and 41-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 and 14-18 is/are allowed.
- 6) ☒ Claim(s) 24, 26, 28, 29, 31, 33-39 and 41-45 is/are rejected.
- 7) ☒ Claim(s) 32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This office action is in response to applicant's amendment filed on April 20, 2004.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### *Claim Objections*

1. Claims 39 and 41-44 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form. In these claims, the features "the moisture barrier entirely covers the surfaces of at least one side/only one side/only two sides/only three sides/only four sides..." is not consistent with the structural limitation recited in the body of the previous claims 24, 28, and 37 since these claims recite the moisture barrier "covering only part of the surfaces of..". This can render a claim indefinite by raising a question or doubt as which limitation feature is claimed and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Applicant may change the limitation in the independent claims 24, 28, and 37 to have the moisture barrier being "coated on at least a part of a surface of at least one side of the wood board".

#### *Claim Rejections - 35 USC § 102*

2. Claims 29, 31, 33, and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Ehrlich (US Patent 2,875,101).

Ehrlich shows and discloses a building structure comprising: an elongated building structure including an elongated wood board (10) having a generally elongated cubicle shape

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with six sides (including four sides and two ends), and an elastomeric membrane of a non-tacky, non-vulcanized, cured liquid rubberized coating material (12) (see col. 2, lines 30-31 and 64-65; col. 3, line 64; col. 4, lines 15-40) coated onto the exterior surfaces of the wooden board (10), and the coating material covering at least a part or an entire surface of at least on side of the wood board, wherein the non-vulcanized, rubberized coating material (12) inherently provides a moisture and condensation barrier which has a thickness sufficient to provide a barrier to prevent moisture penetration into the wooden board. Notice, the building structure of Ehrlich s inherently exposed to and facing toward or away from the moisture condition such that the moisture barrier prevents the moisture penetration from the moisture exposed portion of the building structure to a dry portion of the building structure. Notice the position of the moisture barrier to be located as relative to the moisture condition merely recites a intended use of the product and is give very little patentability weight.

3. Claims 29, 31, 33, and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent No. 11-293807.

The Japanese reference '807 shows and discloses a building structure comprising: at least a portion of the building structure (1A, 1B) including a wood board (3) having a generally elongated cubicle shape with six sides (including four sides and two ends), and an elastomeric membrane of a non-tacky, non-vulcanized, cured liquid rubberized coating material (2) coated onto the exterior of the wooden board (3), and the coating material covering at least a part or an entire surface of at least on side of the wood board, wherein the non-vulcanized, rubberized coating material (2) inherently provides a moisture and condensation barrier which has a

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thickness sufficient to provide a barrier to prevent moisture penetration into the wooden board. Notice, the building structure of the JP reference is inherently exposed to and facing toward or away from the moisture condition such that the moisture barrier prevents the moisture penetration from the moisture exposed portion of the building structure to a dry portion of the building structure. Notice the position of the moisture barrier to be located as relative to the moisture condition merely recites a intended use of the product and is give very little patentability weight.

4. Claims 24, 28-29, 31, 33-37, 39, and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent No.10-237980.

The Japanese reference '980 shows and discloses a building structure comprising: a wooden wall board (11), and an elastomeric membrane of a non-tacky, non-vulcanized, cured liquid rubberized coating material (12) coated onto and covering at least a part of one surface or an entire surface of the wooden wall board (11) such that the non-vulcanized, rubberized coating material (12) inherently provides a moisture and condensation barrier which has a thickness sufficient to prevent moisture penetration into the wall board (11), and wherein the coating material (12) on the wall board (11) is inherently exposed to face toward or away from the moisture condition in the building structure for preventing the moisture penetration from the moisture exposed portion to a dry portion of the building structure when the wall board being installed therebetween. Notice the position of the moisture barrier of the building structure being located as relative to the moisture condition merely recites an intended use of the product and is give very little patentability weight.

***Claim Rejections - 35 USC § 102/103***

5. Claims 24, 28, 37-39, and 41-44 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Japanese Patent No. '807 or Ehrlich '101.

The claims are considered to be met by the Japanese reference '807 or Ehrlich '101 as explained and applied above rejection, wherein the JP reference '807 or Ehrlich shows and teaches the wooden board (3 of JP '807; or 10 of Ehrlich ) having an elongated cubical shape with sixes and having four sides being entirely covered but not part of the surfaces covered by the non-vulcanized, rubberized coating material (2 of JP '807 or 12 of Ehrlich). However, it would have been an obvious matter of design choice to a person of ordinary skill in the art, at the time the invention was made, to modify the building structure of Japanese references '807 or Ehrlich having the coating material covering a selected position in a selected surface of the wood board as claimed because since the applicant has not disclosed that the coating material covering the specific location of building structure at one or all sides of the building structure solves any stated problem or is for any particular purpose applicant and it appears that the claimed invention would perform equally well with the building structure being selectively covered in part by the coating material perform the same function of preventing moisture penetration into the wood board as depend upon the environmental condition of the wood board to be located in the building structure and that needs to be protected.

*Claim Rejections - 35 USC § 103*

6. Claims 38 and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent '980 in view of Japanese Patent '807.

Regarding to above claims, although the Japanese reference '807 or Japanese reference '980 does not specifically define the non-vulcanized, rubberized coating material may cover a part of more one sides of the wooden wall board as claimed, it is common engineering practice to construct a building structure such as wall board which inherently has an elongated configuration with six sides. Japanese Patent '807 also teaches a wooden building structure having an elongated configuration with six sides, and a coating material covering each six sides of the building structure for providing entire protection for the building structure. It would have been an obvious matter of design choice to a person of ordinary skill in the art, at the time the invention was made, to perform equally well of the building structure of Japanese references '980 having the coating material covering variety surfaces of the wood board as claimed as taught by Japanese reference '807 because since the applicant has not disclosed that the coating material covering the specific location of building structure solves any stated problem or is for any particular purpose applicant and it appears that the claimed invention would perform equally well with the building structure being selectively covered by the coating material perform the same function of preventing moisture penetration into the wood board as depend upon the environmental condition of the wood board to be located in the building structure.

7. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ehrlich '101 or Japanese Patent '807, or Japanese Patent '980 as applied to claim 24 above.

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Regarding to claim 26, although either Ehrlich or the Japanese references '807 and '980 do not specify the moisture and condensation barrier having a thickness as claimed. However, it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to create optimal thickness of the barrier as claimed because it would have expected applicant's invention to perform the thickness being equal well as defined by Ehrlich or the Japanese references or as claimed of 4-to-8 mils for sufficiently preventing suitable of penetration of the moisture and condensation, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

***Allowable Subject Matter***

8. Claims 1-7 and 14-18 are allowed.

9. Claim 32 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

10. Applicant's arguments, filed April 20, 2003, with respect to the rejections under Haigh '536 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground of rejection is made in view of newly defined Japanese references as discussed set forth above.

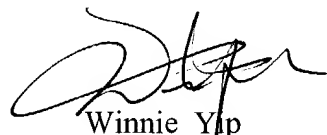


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Winnie Yip whose telephone number is 703-308-2491. The examiner can normally be reached on M-F (9:30-6:30), Second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Winnie Yip  
Primary Examiner  
Art Unit 3637

wsy  
August 6, 2004